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10/693,718

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Kerem B. Karatal

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EXAMINER

DAO, THUY CHAN

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/693,718 | Applicant(s) KARATAL ET AL. | |
| | Examiner Thuy Dao | Art Unit 2192 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-17, 20-27, 29-42 is/are pending in the application.
- 4a) Of the above claim(s) 15, 18, 19 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-17, 20-27, 29-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on December 14, 2007 has been entered.

2. Claims 1-11 have been examined.

Response to Amendments

3. Per Applicants' request, claims 1 and 6 have been amended and claims 12-42 have been cancelled.

4. The 35 USC §101 rejection over claims 6-11 is maintained.

Response to Arguments

5. Applicants' arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections – 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. As set forth in the previous Office Actions mailed January 24, 2007 (page 4) and June 14, 2007 (page 2), claims 6-11 are rejected because the claimed invention is directed to non-statutory subject matter “[a] system implemented by way of one or more computers, comprising: means for exposing a first set of functions ...; means for exposing a

second set of functions ...; and means for exposing a third set of functions ..." (e.g., FIG. 2, programming framework system 132).

In the instant amendments, the Applicants added new limitations "...the hierarchical namespace including functionality to allow application-defined calculations to be performed" (claim 6, lines 4-5) and asserted that "the claim recites statutory subject matter" (Remarks, page 9, paragraph 101 Rejections).

However, as described in FIG. 2, the hierarchical namespaces 200, 202, 204, and 206 merely are software components.

Furthermore, the originally filed disclosure clearly set forth "... may be implemented in hardware of a combination of hardware, software, and/or firmware" (specification, page 54, lines 20-24).

They amount to Functional Descriptive Material: "Data Structures" representing descriptive material per se or "Computer Programs" representing computer listings per se.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast,

a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. See MPEP 2106.

Dependent claims 7-11 do not cure the deficiencies as noted above, thus, also amount to Functional Descriptive Material: "Data Structures" representing descriptive material per se or "Computer Programs" representing computer listings per se.

Under the principles of compact prosecution, claims 6-11 have been examined as the Examiner anticipates the claims will be amended to obviate these 35 USC § 101 issues. For example (proposal only), - *-A system implemented by way of one or more computers, embodied on one or more computer-readable storage media, comprising:* ...- - as similarly recited in independent claim 1.

Claim Rejections – 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WindowsXP Guide (art of record, "Windows XP – Reviewers Guide") in view of Cadiz (art of record, "Sideshow: Providing Peripheral Awareness of Important Information"), and further in view of US Patent Publication No. 2003/0028685 A1 to Smith et al. (art made of record, hereinafter "Smith").

Claim 1:

WindowsXP Guide discloses *a programming interface embodied on one or more computer-readable storage media, comprising:*

a first group of services related to re-usable user interface controls, the first group of services including a control that allows preview images of items to be displayed (e.g., page 29, section Pictures: the windows of life, which displays preview images);

a second group of services related to user interface dialogs and user interface wizards, the second group of services including a first dialog to allow files and folders to be opened and saved (e.g., pp. 9-10, section Enhanced File Management; page 64, section Sharing Files and Folders);

a third group of services related to extending the user interface functionality, the third group of services including functionality to allow identification of application-defined thumbnails (e.g., page 12, Start Menu with application-defined thumbnails); and

a fourth group of services related to extending functionality of a desktop of the user interface (e.g., page 13, setting Desktop Appearance and Themes; page 19, creating Desktop shortcuts; page 12, personalizing Desktop and Welcome screen),

wherein the first and second and third and fourth groups of services are defined of the programming interface (pp. 1-3, Windows XP Overview).

WindowsXP Guide does not explicitly disclose *the fourth group of services including functionality to allow a sidebar to be displayed on the desktop.*

However, in an analogous art, Cadiz further discloses *the fourth group of services including functionality to allow a sidebar to be displayed on the desktop (e.g., page 4, Figure 1, the Sideshow sidebar resides on one edge of the user's desktop, and related text in pp. 4-5).*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Cadiz's teaching into WindowsXP Guide's teaching. One would have been motivated to do so to help users stay aware of large amounts of

dynamic information without overloading or distracting them as suggested by Cadiz (e.g., page 4, left column, section 3. Sideshow).

Neither WindowsXP Guide nor Cadiz explicitly discloses other limitations.

However, in an analogous art, Smith further discloses:

a hierarchical namespace including a set of types for a user interface organized into the hierarchical namespace (e.g., [0047]),

the hierarchical namespace including functionality to allow application-defined calculations to be performed (e.g., FIG. 3, four root namespaces including functionality, [0053]);

a top level identifier prefixed to the name of each group in the hierarchy so that the types in each group are referenced by a hierarchical name that includes the selected top level identifier prefixed to the name of the group containing the type (e.g., FIG. 3, sub-namespaces with prefixed name, [0054]-[0059]).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Smith's teaching into WindowsXP Guide and Cadiz's teaching. One would have been motivated to do so to group API functions into namespaces and by using namespaces, the software designer is able to organize a set or types into a hierarchical namespaces and create multiple groups from the set of hierarchical namespaces as suggested by Smith (e.g., [0046]-[0047]).

Claim 2:

The rejection of claim 1 is incorporated. WindowsXP Guide also discloses *the first group of services includes: a first control that encapsulates a storage user experience; a second control that allows an item to be displayed in an application-defined manner (e.g., page 9-10, 12, and 14); a third control that allows items to be added to a sidebar of the desktop; and a fourth control that allows items to be added to a list (e.g., pp. 11-12).*

Claim 3:

The rejection of claim 1 is incorporated. WindowsXP Guide also discloses *the second group of services includes:*

a first wizard to allow optical discs to be written to (e.g., page 35, section Making Your Own CDs); and

a second wizard to facilitate sending images by electronic mail (e.g., page 42, MSN e-mail and instant message services).

Claim 4:

The rejection of claim 1 is incorporated. WindowsXP Guide also discloses *the third group of services includes:*

a first functionality to allow additions to context menus (e.g., pp. 11-12 personalizing Start Menu and Welcome screen); and

a second functionality to allow calculations to be performed when displaying information regarding one or more files or folders (e.g., page 14, sorting/calculating/managing Files and Folders names, types, and sizes).

Claim 5:

The rejection of claim 1 is incorporated. WindowsXP Guide also discloses *the fourth group of services includes functionality to allow application-defined notifications to be displayed on the desktop (e.g., page 12, Start Menu and application-defined thumbnails).*

Claim 6:

WindowsXP Guide discloses *a system implemented by way of one or more computers, embodied on one or more computer-readable storage media, comprising:*

means for exposing a first set of functions that enable re-usable controls of a user interface (e.g., page 13, setting Appearance and Themes; page 19, creating shortcuts; page 12; personalizing Welcome screen);

means for exposing a second set of functions that enable re-usable dialogs of the user interface and re-usable wizards of the user interface (e.g., page 19,

File and Settings Transfer Wizard; page 21, Hardware Wizard; page 22, Network Setup Wizard); and

means for exposing a third set of functions that enable extending functionality of a desktop of the user interface (e.g., pp. 11-12; page 14),

wherein the means for exposing the first set of functions including means for exposing one or more functions that allow items to be added to a bar of the desktop (e.g., pp. 9-10 section Taskbar).

WindowsXP Guide does not explicitly disclose *one or more functions that allow items to be added to a sidebar of the desktop.*

However, in an analogous art, Cadiz further discloses *one or more functions that allow items to be added to a sidebar of the desktop* (e.g., page 4, Figure 1, the Sideshow sidebar resides on one edge of the user's desktop, and related text in pp. 4-5).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Cadiz's teaching into WindowsXP Guide's teaching. One would have been motivated to do so to help users stay aware of large amounts of dynamic information without overloading or distracting them as suggested by Cadiz (e.g., page 4, left column, section 3. Sideshow).

Neither WindowsXP Guide nor Cadiz explicitly discloses other limitations.

However, in an analogous art, Smith further discloses:

means for organizing a set of types for a user interface into a hierarchical namespace (e.g., [0047]),

the hierarchical namespace including functionality to allow application-defined calculations to be performed (e.g., FIG. 3, four root namespaces, [0053]);

means for selecting a top level identifier and prefixing the name of each group with the top level identifier so that the types in each group are referenced by a hierarchical name that includes the selected top level identifier prefixed to the name of

the group containing the type (e.g., FIG. 3, sub-namespaces with prefixed name, [0054]-[0059]).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Smith's teaching into WindowsXP Guide and Cadiz's teaching. One would have been motivated to do so to group API functions into namespaces and by using namespaces, the software designer is able to organize a set or types into a hierarchical namespaces and create multiple groups from the set of hierarchical namespaces as suggested by Smith (e.g., [0046]-[0047]).

Claim 7:

The rejection of claim 6 is incorporated. WindowsXP Guide also discloses *means for exposing a fourth set of functions that enable extending functionality of the user interface* (e.g., pp. 11-12; page 14).

Claim 8:

The rejection of claim 7 is incorporated. WindowsXP Guide also discloses *the means for exposing the fourth set of functions comprises:*

means for exposing one or more functions to allow additions to context menus (e.g., page 13, 19, and 12);

means for exposing one or more functions to allow identification of application-defined thumbnails (e.g., page 12); and

means for exposing one or more functions to allow calculations to be performed when displaying information regarding one or more files or folders (e.g., page 14).

Claim 9:

The rejection of claim 6 is incorporated. WindowsXP Guide also discloses *the means for exposing the first set of functions comprises:*

means for exposing one or more functions that encapsulate a storage user experience; means for exposing one or more functions that allow an item to be displayed in an application-defined manner (e.g., page 12; page 19);

means for exposing one or more functions that allow items to be added to a sidebar of the desktop; means for exposing one or more functions that allow items to be added to a list (e.g., page 12; page 21-22); and means for exposing one or more functions that allow preview images of items to be displayed (e.g., page 29).

Claim 10:

The rejection of claim 6 is incorporated. WindowsXP Guide also discloses *the means for exposing the second set of functions comprises:*

means for exposing one or more functions that allow files and folders to be opened and saved (e.g., pp. 9-10);

means for exposing one or more functions that allow optical discs to be written to (e.g., page 35); and

means for exposing one or more functions that allow images to be sent by electronic mail to be re-sized (e.g., page 29-31).

Claim 11:

The rejection of claim 6 is incorporated. WindowsXP Guide also discloses *the means for exposing the third set of functions comprises means for exposing one or more functions that allow a sidebar to be displayed on the desktop (pp. 9-10); and means for exposing one or more functions that allow application-defined notifications to be displayed on the desktop (e.g., pages 12 and 19).*

Conclusion

10. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone/fax numbers are (571) 272 8570 and (571) 273 8570, respectively. The examiner can normally be reached on every Tuesday, Thursday, and Friday from 6:00AM to 6:00PM.

Art Unit: 2192

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T Dao/

/Tuan Q. Dam/

Supervisory Patent Examiner, Art Unit 2192